

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Marc Peters-Golden *et al.*  
Serial No.: 09/291,656 Art Unit.1653  
Filed: 03/03/199 Examiner: Carlson  
Entitled: **Administration Of Products Of The 5-Lipoxygenase Metabolic  
Pathway To Enhance Antimicrobial Defense**

**REPLY BRIEF (37 CFR § 1.193) TO EXAMINER'S  
ANSWER MAILED OCTOBER 16, 2008**

Mail Stop - Appeal  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being deposited with the U.S. Patent and Trademark Office, via EFS.

Dated: December 8, 2008

By: 

Traci E. Light

Examiner Carlson:

Please enter the following Reply Brief on the record in answer to the Examiner's Answer mailed October 16, 2008 wherein new arguments were made. Pursuant to 37 CFR § 1.193, the Applicants hereby provide a rebuttal to these new arguments.

Since the Reply Brief is filed within two months of the date of mailing of the Answer, the Reply Brief is timely. Nonetheless, if there are any fees required and/or any required Petition for Extension of Time for filing this Reply Brief, they are dealt with in the accompanying **TRANSMITTAL OF REPLY BRIEF**.

## ARGUMENT

The Examiner raises new points of argument in the context of rephrasing old arguments. The Applicants provide argument below in rebuttal to the Examiner's new arguments. In regards to other statements within the Examiner's Answer, not explicitly referred to herein, the Applicant's Appeal Brief is herein incorporated by reference.

### I. 'An Aerosol' Is A Composition Of Matter

The Examiner improperly relies on the Board Decision mailed May 30, 2007 in attempting to support that:

Claims 22-25 and 27 stand rejected under 35 U.S.C. 102(e) as being anticipated by Gosselin et al. (USP 5,789,441 ...) ...[because] ... Gosselin et al. teach leukotriene LTB<sub>4</sub> in a sterile liquid ...

*Examiner's Answer, pg. 4.* In making this conclusion the Examiner is misconstruing the Applicants' presently claimed embodiment as well as misunderstanding the true nature of the Board's holding. The Applicants argue that the Board's holding allegedly equated Gosselin's "solution" to the Applicants' "solution" because the Applicants claimed embodiment, at the time of the last Appeal, was drawn to "a solution". The Applicants' claims presently at issue are not drawn to "a solution", but are drawn to "an aerosol". The Board very clearly made this point within the Examiner's cited passages:

While we agree with Appellants that claim 22's "wherein" clause limits the claim to a solution in the form of an aerosol, we do not agree that that limitation distinguishes the claimed solution from that of Gosselin. ...

Thus, claim 22's limitation that the "solution is an aerosol" does not distinguish the claimed solution from the solution disclosed by Gosselin and the '059 Application.

*Examiner's Answer, pg 5* [emphasis added]. The Board merely held that when a claim is phrased as "a solution in the form of an aerosol" and the definition of "aerosol" in the specification might encompass a "solution under pressure" then Gosselin et al. is allegedly prior art. The Board did not hold that when a claim is phrased as "an aerosol"

and further limited to “a gaseous suspension of fine or liquid particles” then Gosselin et al. is prior art. In fact, Gosselin et al. does not disclose “a gaseous suspension” and therefore cannot anticipate the Applicant’s claimed embodiment.

The Examiner provides a new argument that:

Appellants urge that Claim 22 is drawn to a sterile vehicle and not to a sterile liquid as taught in Gosselin. One is encompassed by the other, and therefore the statement stands.

*Examiner’s Answer, pg. 7.* The Applicants disagree and submit that the proper interpretation of Claim 22 is not as “drawn to a sterile vehicle” as suggested by the Examiner, but as “drawn to a gaseous suspension”, as fully explained to the Examiner in past Office Action responses. Further, the Examiner’s misunderstanding of the importance between “a solution” and “an aerosol” is reflected in the closing sentence of the Examiner’s Answer:

Appellants are referred again to the Board’s statement that the solutions are not distinguishable and therefore that Gosselin anticipates the claimed aerosol solutions.

*Examiner’s Answer pg 8.* The Applicants point out that the Examiner is now erroneously alleging that the presently claimed embodiment is drawn towards an “aerosol solution”. This is clearly not the case. The Applicants have claimed “a gaseous suspension” without any reliance on any kind of solution<sup>1</sup>. The Examiner is in error by suggesting that the Board’s opinion supports the Examiner’s interpretation.

In light of the above arguments, the Applicants respectfully request that the Examiner withdraw the pending rejection.

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<sup>1</sup> It is respectfully submitted that the explicit claim language excludes “a solution under pressure”.

**II. Gosselin et al. Does Not Teach An Aerosol Comprising An Antibiotic**

The Examiner further alleges that:

Claims 22 and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. ... Gosselin et al. do not expressly teach that to include an antibiotic to a solution comprising a sterile liquid and a leukotriene. ... Therefore, it would have been obvious to a person having ordinary skill in the art to include an antibiotic in a solution ...

*Examiner's Action*, pg. 5 [emphasis added]. The Examiner has repeated the same improper claim interpretation by arguing that the presently claimed embodiment is allegedly drawn towards “a solution”. As the Applicants have argued above (herein incorporated by reference), the presently claimed embodiment directly recites “a gaseous suspension”. Gosselin et al. does not disclose “a gaseous suspension” and therefore fails to support a *prima facie* case of obviousness because the reference (and/or any other supportive evidence provided by the Examiner<sup>2</sup>) does not teach all the elements. The Examiner provides passages from page 7 and 8 of the Board’s Decision in apparent support for this rejection. However, the Applicants have not found that the cited paragraphs have any relevance to Claim 38.

In light of the above arguments, the Applicants respectfully request that the Examiner withdraw the pending rejection.

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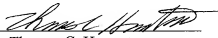
<sup>2</sup> At no time in the examination of these claims, has the Examiner offered any evidence support by either an affidavit or provided service of Official Notice to support an obviousness rejection.

**CONCLUSION**

For the reasons set forth above, it is respectfully submitted that Applicants' Claims 22-25, 27 and 38 should be passed to allowance. Appellants ask that the Board reverse the Examiner and send the case on for disposition consistent with the above.

Respectfully submitted,  
Medlen & Carroll, LLP

Dated: December 8, 2008

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